

Remarks

This Application has been carefully reviewed in light of the Office Action mailed August 13, 2003. Applicant appreciates the Examiner's consideration of the Application. To clarify various aspects of Applicant's claims, Applicant has amended Claims 1-47. These amendments are not considered necessary for patentability, and have not introduced any new matter. Applicant respectfully requests reconsideration and allowance of all pending claims.

Objection to Claim 46

Applicant has amended Claim 46 to correct a typographical error. Applicant respectfully requests that the Examiner withdraw this objection to Claim 46.

Claims 11-32 and 47 Recite Patentable Subject Matter

The Examiner rejects Claims 11-32 and 47 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Although Applicant believes Claims 11-32 and 47 recite patentable subject matter without amendment, Applicant has amended independent Claims 11, 22, and 47 to further clarify that Claims 11, 22, and 47 recite computer-implemented methods and are directed to patentable subject matter. These clarifying amendments are not narrowing and do not constitute new matter. Applicant respectfully requests withdrawal of this rejection of Claims 11-32 and 47 under 35 U.S.C. § 101.

Claims 1-47 Are Allowable Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejects Claims 1-47 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Although Applicant believes Claims 1-47 comply with 35 U.S.C. § 112, second paragraph, without amendment, Applicant has made clarifying amendments to Claims 1-47, none of which are considered necessary for patentability. However, Applicant respectfully disagrees with certain aspects of this rejection.

For example, the Examiner objects to use of the phrase "operable to" throughout the claims as being vague and indefinite. (*See* Office Action, Page 4) Applicant respectfully disagrees. A system element described as "operable to" perform certain functions covers

operations that the element *is* capable of performing, and not just operations that the elements *may be* capable of performing. Applicant notes that the ordinary dictionary definition of "operable" is "practicable." *The American Heritage College Dictionary*, 3rd Ed., Houghton Mifflin (1997) The dictionary definition of "practicable" is "capable of being affected, done or put into practice." *Id.* Thus, as stated above, elements following the term "operable to" in a particular claim element constitute operations that the claim element *is capable* of performing. Operations that a claim element *is capable* of performing are limitations, because the element is thus distinguished from the prior art that *is not capable* of performing the operations. Applicant further notes that "operable to" is a commonly used term in patent application claims, and is present in claims of numerous patents issued by the United States Patent and Trademark Office. A search in the claims field of the United States Patents Database of Westlaw Legal Research Service produced well over 1000 issued patents that include the term "operable to" in the claims. For at least these reasons, Applicant respectfully submits that use of the phrase "operable to" complies with 35 U.S.C. § 112, second paragraph.

As another example, the Examiner indicates various issues with respect to the terms "constraint" and "culprit." (*See* Office Action, Pages 5-6) Applicant respectfully submits that the meaning of these claim terms is clear in the claims. M.P.E.P. § 2173.02 states, "In reviewing a claim for compliance with 35 U.S.C. § 112, second paragraph, the Examiner must consider the claim as a whole to determine whether the term apprises one of ordinary skill in the art of its scope, and therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent." "The test for definiteness under 35 U.S.C. 112, second paragraph, is whether 'those skilled in the art would understand what is claimed when the claim is read in light of the specification.'" *Id.* citing *Orthokinetics, Inc. v. Safety Traveltures, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). In light of this standard, the Examiner is directed to at least the discussion of Figure 4 beginning on page 16 of the Specification, which provides an example embodiment in which these claim terms are explained. Furthermore, the Examiner states that the claim terms "constraint" and "culprit" both "imply the occurrence of something that impedes fulfillment of the request." (Office Action, Page 5) Applicant does not necessarily agree or acquiesce to this interpretation of the terms

"constraint" and "culprit." For at least these reasons, Applicant respectfully submits that the use of the terms "constraint" and "culprit" comply with 35 U.S.C. § 112, second paragraph.

As another example, the Examiner states with reference to Claim 4 that "it is not understood how it can be said that the first and second entities are optimizing their respective production independent of one another." (Office Action, page 6). Applicant directs the Examiner's attention to at least page 10, lines 3-15 of the Specification.

For at least these reasons, Applicant respectfully requests withdrawal of this rejection of Claims 1-47 under 35 U.S.C. § 112, second paragraph.

Requirement for Information and Patentability Under 35 U.S.C. § 102

The Examiner states that an issue of public use on sale activity has been raised in the Application, and that in order for the Examiner to properly consider patentability of the claimed invention under 35 U.S.C. § 102(b), additional information regarding this issue is required. In particular, the Examiner includes a Requirement for Information with respect to i2 Technologies, Inc.'s RHYTHM product, requesting information regarding the capabilities of RHYTHM as it existed prior to October 8, 1998, and how it differs from the claimed invention.

After reasonable inquiry, Applicant believes he has identified materials responsive to the Examiner's Requirement for Information, which are submitted herewith and listed in Appendix A. Furthermore, Applicant believes that the RHYTHM product, as it existed prior to October 8, 1998, did not incorporate various capabilities or features recited in Claim 1. For example, at a minimum, the RHYTHM did not incorporate the following limitations recited in Claim 1 in which a system is operable to:

- establish a demand at the second entity for one or more supplies supplied by the first entity, the demand for the supplies based at least in part on a demand placed on the second entity by a third entity downstream from the second entity;
- optimize the second entity's production associated with meeting the demand from the third entity to generate the request for the supplies;

- communicate the request for the supplies to the first entity, a system associated with the first entity operable to optimize the first entity's production of the supplies using the request for the supplies as a first constraint to generate a promise for the supplies based on the request for the supplies;
- receive the promise for the supplies from the first entity, the promise for the supplies having been generated according to an optimization of the first entity's production of the supplies using the request for the supplies as a first constraint, the promise for the supplies identifying a culprit as a cause for the promise for the supplies not satisfying the request for the supplies if the promise for the supplies does not satisfy the request for the supplies;
- if the promise for the supplies does not satisfy the request for the supplies, generate a second constraint according to the culprit identified in the promise for the supplies; and
- if the promise for the supplies does not satisfy the request for the supplies, reoptimize the second entity's production associated with meeting the demand from the third entity using the second constraint generated according to the culprit identified in the promise for the supplies to generate a new request for the supplies.

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Applicant hereby takes a one-month extension of time from November 13, 2003 to December 13, 2003 for responding to this Office Action. The Commissioner is hereby authorized to charge the \$110.00 one-month extension of time fee and to further charge any deficiency or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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Date: 12/15/03